

REMARKS

Claims 1-36 are pending in the present application. Claims 1, 4-8, 13, 16-20, 25 and 28-32 have been amended herewith. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 102, Anticipation

The Examiner rejected Claims 1-5 and 13-17 under 35 U.S.C. § 102(e) as being anticipated by Hamilton (US 2002/0176377). This rejection is respectfully traversed.

For a prior art reference to anticipate in terms of 35 U.S.C. 102, every element of the claimed invention must be *identically shown* in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Applicants will now show that every element of the claimed invention is not identically shown in a single reference, and thus this 35 USC 102 rejection is shown to be in error.

With respect to Claim 1, such claim is directed to a method for detecting whether the mobile telephone is present within a pre-defined area; and responsive to detecting that the mobile telephone is present within the pre-defined area, writing data to a billing record to indicate that a second party has been billed for mobile telephone airtime charges of the at least one party operating a mobile telephone, wherein the second party is a party other than the at least one party operating a mobile telephone. The cited reference does not teach any type of pre-defined area, and thus it necessarily follows that the cited reference does not teach a step of detecting whether a mobile phone is present within such (missing) pre-defined area. It similarly follows that as there is no teaching of detecting whether the mobile phone is present within a pre-defined area, there is no teaching of the 'responsive' action that results from such pre-defined area detecting step – and in particular there is no teaching of a step of writing data to a billing record to indicate second party billing that is responsive to such (missing) detecting step.

In rejecting Claim 1, the Examiner states that charges can be sponsored fully by another party based on policies which *could* include location data. The cited reference is silent as to any policy that includes location data. The fact that the teachings of the cited reference *could* be modified to include location data policies is insufficient to establish anticipation, as every element of the claimed invention *must be identically shown* in a

single reference. Quite simply, the cited reference does not teach any type of location data policy that is used for sponsor billing, and thus the cited reference does not teach every element of the claimed invention.

The teachings of the cited reference and the presently claimed invention are somewhat akin to a genus/species analysis, where the reference mentions use of policies generally, but does not teach the specific type of policy as per the present invention. Per MPEP 2131.02, a species will anticipate a claim to a genus ("A generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus." The species in that case will anticipate the genus. In re Slayter, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960); In re Gosteli, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989)), but a genus does not always anticipate a claim to a species within the genus (A genus does not always anticipate a claim to a species within the genus. However, when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990)). In this case, the species (pre-defined area determines who to bill) is not clearly named, as there is no clear teaching of any use of location data *to determine billing of another* for a phone call made by the user of the phone. Instead, the sponsor who is participating in the session with the user is the one who is billed (page 1, paragraph [0008]; page 2, paragraph [0012]) – irrespective of the location of the mobile phone user.

It is further shown that while the cited reference does make mention of a user location, the user location is not used in determining *who* to bill, but *how* to bill (paragraph [0033]). Again, the sponsor who is participating in the session with the user is the one who is billed – irrespective of the location of the mobile phone user. Applicants have amended Claim 1 to further clarify this distinction. Therefore, it is urged that amended Claim 1 is not anticipated by the cited reference.

Applicants initially traverse the rejection of Claims 2-5 for similar reasons to those given above with respect to Claim 1.

Further with respect to Claim 4, such claim has been amended to recite the feature of "wherein the second party is at least one of (i) a retailer having a place of business physically located at least partially within the at the pre-defined geographic location, (ii)

an employer having a place of business physically located at least partially within the predefined geographic location, and (iii) a school establishment having a place of business physically located at least partially within the predefined geographic location", as described at Specification page 22, lines 9-26. It is urged that the cited reference does not teach any type of retailer, employer or school establishment billing for the retailer/employer/school establishment of where the mobile phone is physically located. It is therefore further urged that Claim 4 is not anticipated by the cited reference.

Further with respect to Claim 5, such claim has been amended to recite the feature of "wherein the pre-defined geographic area is with respect to a business establishment that is physically located at least partially within the predefined geographic area, and wherein the at least one party initiates a call within the pre-defined geographic area, and the mobile telephone airtime charges are associated with the call and billed to the business establishment". It is urged that the cited reference does not teach any type of business establishment billing for the billing establishment of where the mobile phone is physically located. It is therefore further urged that Claim 5 is not anticipated by the cited reference.

Applicants traverse the rejection of Claims 13-17 for similar reasons to those given above with respect to Claims 1-5.

Therefore, the rejection of Claims 1-5 and 13-17 under 35 U.S.C. § 102 has been overcome.

II. 35 U.S.C. § 103, Obviousness

A. The Examiner rejected Claims 1, 6, 13, 18 and 25 under 35 U.S.C. § 103 as being unpatentable over Nightingale et al. (US Pat# 6,546,238). This rejection is respectfully traversed.

The cited Nightingale reference is directed to a technique whereby a landline phone user can assume certain charges of a call that they themselves make to a mobile phone. Importantly, the party being billed is not determined by the location of the mobile telephone. Rather, the *party making the call* is billed irrespective of the location of the mobile telephone. While the cited reference does allude to a "visiting MSC" which is a mobile switching center, detection of such a visiting MSC is not used in deciding who to

bill, but rather is used in determining that the call needs to be forwarded – i.e. the location is used for call routing, and not used for determining *who* to bill for the call. In any event, Applicants have amended Claim 1 to further clarify this distinction. It is thus urged that amended Claim 1 is not obvious in view of the cited reference, as each of the claimed elements are not taught or suggested by the cited reference¹.

Applicants traverse the rejection of Claims 6, 13, 18 and 25 for similar reasons to those given above with respect to Claim 1.

Therefore, the rejection of Claims 1, 6, 13, 18 and 25 under 35 U.S.C. § 103 has been overcome.

B. The Examiner rejected Claims 7-12, 19-24 and 31-36 under 35 U.S.C. § 103 as being unpatentable over Hamilton et al. (US 2002/0176377) in view of Malackowski et al. (US 2003/0027555). This rejection is respectfully traversed.

With respect to Claim 7, none of the cited references teach or suggest – nor has the Examiner alleged any teaching or suggestion of – the claimed feature of “wherein the at least one party *enters the pre-defined area while a call is in progress*, and the mobile telephone airtime charges are associated with the call”. Therefore, the Examiner has failed to properly establish a prima facie showing of obviousness with respect to Claim 7, and the burden has not shifted to Applicants to rebut the rejection of Claim 7².

With respect to Claims 8-12, Applicants traverse for reasons given above with respect to Claim 1, and Applicants urge that the cited reference does not teach or otherwise suggest the missing claimed features identified above with respect to Claim 1.

With respect to Claim 19 (and similarly for Claim 31), Applicants traverse for similar reasons to those given above with respect to Claim 7.

With respect to Claims 20-24 (and similarly for Claims 32-36), Applicants traverse for similar reasons to those given above with respect to Claims 8-12.

¹ To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. See also, *In re Royka*, 490 F.2d 580 (C.C.P.A. 1974).

² In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.*

Therefore, the rejection of Claims 7-12, 19-24 and 31-36 under 35 U.S.C. § 103 has been overcome.

C. The Examiner rejected Claims 25-30 under 35 U.S.C. § 103 as being unpatentable over Hamilton (US 2002/0176377). This rejection is respectfully traversed for similar reasons to those given above with respect to Claims 1-5, and Applicants urge that the cited reference does not teach or otherwise suggest the missing claimed features identified above with respect to Claims 1-5.

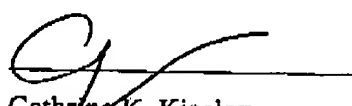
Therefore, the rejection of Claims 25-30 under 35 U.S.C. § 103 has been overcome.

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 8/17/05

Respectfully submitted,


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